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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,482	12/13/2001	Mario Polegato Moretti	216895US6PCT	5928

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1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/009,482

Applicant(s)

MORETTI, MARIO POLEGATO

Examiner

Ted Kavanaugh

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26-50 is/are pending in the application.
- 4a) Of the above claim(s) 28,29,31-33,40,48 and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26,27,30,34-39,41-47,50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Applicant's election with traverse of species I (figures 1-2) in Paper No. 9 is acknowledged. The traversal is on the ground(s) that according to MPEP 806.04(f), the examiner fails to recite mutually exclusive characteristics and there is no serious burden. This is not found persuasive because this applicant was filed under 35 USC 371 and therefore the rules for lack of unity must be applied. The species listed in the last office action do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The special technical feature that is common among all of the species is not a special technical feature since the generic claims do not avoid the prior art, such as Patent No. RE 34,980 and the other prior art applied in the rejection below. Regarding the burden argument, while the searches may overlap the search would be burdensome and longer because the examiner would need to search for five distinct inventions or variations. Furthermore, the search is only part of the examination process, the MPEP 803 states "If the search and examination of an entire application..." (underline added) can be made without serious burden". The examination of the application would be burdensome because the examiner would be required to apply art and rejections to six distinct and different species of invention.

If the application wasn't filed under as a 371 Application the appropriate section of the manual that would have been applied is set forth at MPEP 808-808.01(a), and 809.02(a). And while it is true that the examiner is required to explain why the claimed inventions are independent and to set forth reasons for insisting upon restriction (MPEP 808), these requirements are satisfied when the examiner merely determines that the species, as claimed are

Art Unit: 3728

directed to mutually patentable inventions and requires election of species (see MPEP 808.01(a), and note the discussion in MPEP 806.04(h) which is referenced therein. See also MPEP 809.02(a) and paragraph 8.01 referenced therein). The examiner is not required to show a reasons for insisting on restriction (a burden) such as separate classification or separate status in the art (see MPEP 808.01(a), last two lines of the first paragraph. For a list of the various reasons for insisting on restriction (burden), see clause D. of the sample restriction letter included in MPEP 817). The examiner is only required to follow the practice set forth in MPEP 809.02(a). And the reason why this section of the Manual of Patent Examining Procedure does not require that the examiner demonstrate the facts which support the conclusion required by MPEP 806.04(a) that the claimed species are patentable, one over the other, is that once the examiner is satisfied that the claimed species are patentable one over the other, applicant may negate the requirement simply by filing an appropriate traverse. That traverse is a simple statement in the nature of an admission on the record that applicant does not find that the claimed species are patentable, one over the other. No more reasons need to be presented by applicant than were presented by the examiner. Applicant does not, therefore, need a detailed analysis of why the examiner has held that the claimed species are capable of supporting separate patents. For if the examiner determines that the claimed species are capable of supporting separate patents, then the Office will in fact issue separate patents (assuming the species to be patentable) for each of the species, without applying any strictures under double patenting (see 35 USC 121). If applicant feels otherwise, applicant need only so state, positively, on record. Then the restriction requirement will be withdrawn, and all of the claimed species will be examined in one application. Of course, in the event that a generic claim is found allowable, the election

requirement will also be withdrawn in this application, MPEP 809.02(b). Applicant is not, however, entitled to an examination of claims directed to multiple independent inventions in one application. And inventions are independent when, as disclosed, they are species under a genus, as discussed in MPEP 806.04, and not also dependent inventions.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 28,29,31-33,40,48-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the edge of the membrane folded around the edge of the protective element (claim 37) and the protective edge thinned at its edge (claim 38) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

4. Claims 26-27,30,34-38,41-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26, the last line, the phrase "its internal part which is adjacent to a ground contact surface" is unclear and indefinite.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 26-27,30,34-36,38,39,41,42,44-47 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/14326 (Polegato).

Polegato teaches a breathable shoe and the method of making the shoe substantially as claimed including an assembly having an upper and a breathable lining, at least one waterproof and breathable membrane, a perforated elastomeric sole having through holes, joined to the upper and sealed perimetriclly to said membrane, a protective element which is resistant to hydrolysis, water-repellent, breathable or perforated made out of Kevlar fabric, spot gluing the upper to the lining, and wherein said sole is joined by hydrolysis-resistant adhesives or high-frequency welding, wherein the sole is injection molded. Regarding claim 27, see page 6, lines 20-24. Regarding claim 38, see figure 7 which shows the protective element (316) that is tapered and with the same perimeter as the membrane (315). Regarding claims 45 and 50, applicant teaches both methods of initially attaching the membrane to the upper assembly, then to the outsole and vise versa. The inventors are the same and therefore the elements are similarly labeled.

Art Unit: 3728

7. Claim 26,30,34-37,39,41-44,47 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/51177 (Polegato).

Polegato teaches a breathable shoe substantially as claimed including an assembly having an upper and a breathable lining, at least one waterproof and breathable membrane, a perforated elastomeric sole having through holes, joined to the upper and sealed perimetrially to said membrane, a protective element which is resistant to hydrolysis, water-repellent, breathable or perforated made out of Kevlar fabric, spot gluing the upper to the lining, wherein said sole is joined by hydrolysis-resistant adhesives or high-frequency welding, and wherein the sole is injection molded. Regarding claim 37, see figure 10 which shows the membrane (815) folded around an edge of said protective element (816). Regarding claim 50, see figure 10 which shows the membrane attached to the sole before being attached to the upper assembly. Regarding claim 43, see page 6, lines 5-18. The inventors are the same and therefore the elements are similarly labeled.

### ***Conclusion***

**Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.**

¶. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information

Art Unit: 3728

without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to (703) 872-9303 (FORMAL FAXES ONLY). If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.


Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
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If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
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Application/Control Number: 10/009,482  
Art Unit: 3728

Page 8

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
July 24, 2003